

5/31/88

R-1988-2

UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE COMMISSIONER OF PATENTS AND TRADEMARKS

In re	,)	Decision on Petition
Petitioner)	for Review under
)	Rule 10.2(c)

, hereinafter petitioner,
requests review under 37 CFR 10.2(c) of the Decision on
Request for Regrade on the Afternoon Section of the
Examination Held on October 6, 1987, which was rendered on
April 1, 1988 by the Director of the Office of Enrollment
and Discipline (OED), hereinafter Director. Petitioner
seeks an award of at least eight points to his score to give
him a passing grade.

BACKGROUND

Petitioner took the examination for registration to
practice before the Patent and Trademark Office on October
6, 1987. He passed the morning section but received less
than the minimum 70 points (out of 100) on the afternoon
part necessary to be registered. A request for regrading on
questions 2, 3, 5 and 6 was received on February 29, 1988.
In his decision on the request, the Director added 2 points
for question 2, no points for question 3, 3 points for
question 5, and no points for question 6, which resulted in
a total score of 62 points. On April 30, 1988, this
petition was filed seeking at least 4 points on question 2,
full credit on question 3, 2 points on question 5 and 3
points on question 6.

FACTUAL REVIEW

Question 2

This question asks for the preparation of an
information disclosure statement. A number of patents and
various activities of the coinventors were to be considered
for inclusion in this statement.

The initial grader deducted 10 points (out of 15). On
review, the Director added 2 points because petitioner's
answer indicated that a copy of the patent should be
enclosed with the statement, which avoids the need to
mention the issue date of this patent.

Petitioner argues that there was double counting in the
deduction of 6 points for his discussion of "materiality"
and that his statement about the date of conception was
correct.

Question 3

This question also relates to preparing an information disclosure statement. It adds to the fact situation of the previous question a coinventor's prior use and reduction to practice of the invention in the United States. The examinees were asked if they would modify the disclosure statement and explain either a "yes" or "no" answer.

The grader deducted 12 points (out of 20) because petitioner did not discuss a number of issues raised by the facts. The Director did not add any points because the petitioner did not give any reasons for his conclusion that the statement should not be modified.

Petitioner argues that the model answer is wrong and that most, if not all, the points deducted should be added back. In the alternative, he requests more partial credit because he asserts that there was some double counting in the deduction of points for the same error.

Question 5

This question asks the examinees to draft a species claim which would provide for literal infringement of a particular device and explain why the claim is permissible. The model answer assigned 10 points for a claim drawn to a specific embodiment and 5 points for showing its basis in the specification.

The grader deducted 5 points (out of 15) because the petitioner's answer did not cite Example III as support for the added claim. The Director added 3 points although he concluded that petitioner's reliance for support on broad claim 1 was not appropriate.

Petitioner argues that he should receive full credit because claim 1 was with the application as filed and therefore is part of the original disclosure.

Question 6

This question focuses on obtaining an early application filing date in the PTO when not all the required parts including a filing fee are available.

The grader deducted 10 points (out of 15) because petitioner's answer did not mention express mailing (6 points), omitted naming the inventor in the accompanying papers (3 points), and did not discuss the need to pay a

surcharge when the missing parts were filed later (1 point). On his review, the Director did not add any points because petitioner's answer did not disclose how the application was to be filed, that the inventor's name must be identified and that the particular fee was a surcharge. As explained by the Director, the question was in two parts: how to get a filing date and then how to complete the application.

Petitioner seeks more partial credit because it was not clear from the facts that the inventor's name was missing.

DECISION

Question 2

A thorough and detailed review of the entire record indicates that too many points were deducted. For example, petitioner lost 2 points for mentioning that the conception date occurred on June 14, 1987. As previously explained by the Director, the stated facts do not support this conclusion which is based on an assumption by petitioner. However, this error has no direct relevance to the preparation of the particular information disclosure statement and so should not have resulted in a deduction of any points.

On the other hand, petitioner's discussion about the co-inventor's activities in Canada does relate to the issue covered by this question. Petitioner lost 2 points for using the term "relevant" instead of "material" and 2 more points for "incorrect reasoning" for saying that these activities were relevant instead of immaterial because applicants may not rely on them to establish a date of invention. Thus, in effect petitioner lost points for giving the wrong answer and using incorrect reasoning, which has the appearance of "double counting."

These deductions have the effect of giving considerable weight to the particular errors in view of petitioner's substantively correct answer. Accordingly, 4 points will be added to petitioner's score for this question.

Question 3

Petitioner argues that the model answer and its explanation is wrong and suggests that the PTO must prove that it is right. On the contrary, the burden of proof in this matter lies with the petitioner who must demonstrate the error in the decision by the Director. Accordingly, no further basis nor justification for the model answer will be provided.

With respect to the assertion that the deduction of 12 points is excessive, it is noted that the correct answer is "yes" and petitioner's answer of "no" does not have an adequate explanation. His answer indicates that the information disclosure statement does not have to be modified because the invention was reduced to practice in Canada. The significance of this statement is not understood because under 35 USC 104, foreign acts are not relevant. Further, petitioner's answer does not seem to recognize the consequence of Smith's prior use in the United States under 35 USC 102(a) and prior reduction to practice in the United States under 35 USC 102(g) with respect to Wisdom's invention set forth in claim 2.

Therefore, the award of 8 points in partial credit for a wrong answer is considered to be rather generous especially since petitioner's answer shows no awareness of a number of the issues raised by the facts of this particular question. No additional points will be added to petitioner's score for this question.

Question 5

Petitioner's argument that an original claim is part of the disclosure is correct. However, the narrowing of a claim without support in the specification raises a problem with the description requirement in 35 USC 112. See In re Smith, 173 USPQ 679 (CCPA 1972). Therefore, the preferred answer is to rely on Example III for support of the species claim. No additional points will be added to petitioner's score for this question.

Question 6

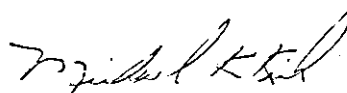
Petitioner has not shown any error in the Director's decision to sustain the grader's deduction of 10 points (out of 15). The facts stated in this question were that the "application was prepared in good order." This is not considered to suggest that the papers which were filed named the inventor. What was actually filed according to the model answer was the specification which generally does not identify the inventor. The declaration was not filed because it was incomplete and it is this document that tells the PTO who the inventor is. Accordingly, no points will be added to petitioner's score for this question.

CONCLUSION

The Director's decision of April 1, 1988 is modified to the extent of restoring four points deducted by the Director from petitioner's score in the afternoon section of the examination on October 6, 1987. Petitioner, however, has not achieved a passing score of 70 points or more in the afternoon section.

Therefore, this petition is denied.

Dated: 5/31/88



MICHAEL K. KIRK
Assistant Commissioner
for External Affairs